Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RUSSELL P. CASHMAN and RICHARD A. SCHWARTZ

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Appeal No. 2001-1563
Application No. 09/151,580

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ON BRIEF

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Before JERRY SMITH, FLEMING, and GROSS, ***Administrative Patent Judges***.

GROSS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3, 6 through 10, and 16. The examiner has objected to claims 4 and 5 as containing allowable subject matter but being dependent from rejected base claims. Claims 11 through 15 and 17 have been canceled.

Appellants' invention relates to a wireless communication system which switches between data communication and voice communication. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for concurrently monitoring communications in a first cellular communication system and a second cellular communication system, comprising the steps of:

a. registering a wireless subscriber station for communication in both the first and second communication systems;

b. communicating in the first system until there is a lack of activity in the first system for a first predetermined time period;

c. entering a sleep mode in the first system;

d. communicating in the second system for a second predetermined time period; and

e. exiting the sleep mode in the first system and proceeding to step b.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Raith et al. (Raith) 5,806,007 Sep. 08, 1998

T. Melanchuk et al., ***CDPD and emerging digital cellular systems***, Compcon '96, Feb. 25-28, 1966, at 2-8. (Melanchuk)

Claim 9 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1 through 3, 6 through 9, and 16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Raith.

Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Raith in view of Melanchuk.

Reference is made to the Examiner's Answer (Paper No. 15, mailed January 5, 2001) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 14, filed November 16, 2000) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the indefiniteness rejection of claim 9, the anticipation rejection of claims 1 through 3, 6 through 9, and 16, and the obviousness rejection of claim 10.

The examiner (Answer, pages 3-4) rejects claim 9 under 35 U.S.C. § 112, second paragraph, asserting that the claimed IS-136 specification is indefinite. Specifically, the examiner argues that "specifications and standards change over time, hence, it is inappropriate to have the scope of a claim change with time." The examiner asserts that "[i]f the scope of the invention sought to be patented cannot be determined from the language of the claims, a second paragraph rejection is appropriate."

Appellants argue (Brief, page 5) that (a) "the Examiner has not shown that the specifications have changed since the date of

filing of the application," (b) "a determination of whether or not claimed subject matter is definite is made at the time of filing the patent application," and (c) "[a]t the time of filing the present application, there existed an IS-136 specification that was determinable by one of ordinary skill in the art." We agree. The claimed IS-136 specification was determinable at the time of filing, and thus is definite. Further, it is not clear whether the claimed specification has changed anyway. Accordingly, we cannot sustain the rejection of claim 9 under 35 U.S.C. § 112, second paragraph.

The examiner (Answer, pages 4-10) rejects claims 1 through 3, 6 through 9, and 16 as being anticipated by Raith. The examiner (Answer, page 9) points to figure 6(b) of Raith as disclosing the steps of claim 1. In particular, the examiner indicates that appellants' step of communicating in a first system until there is a lack of activity for a first predetermined time period corresponds to Raith's arrow 1 (which leads to the CDPD active mode) and arrow 2 (the "active timer"). The examiner continues that appellants' entering a sleep mode in the first system corresponds to Raith's CDPD passive mode at the end of the active timer. We agree with the examiner up to this point. However, the examiner contends that appellants'

communicating in the second system for a second predetermined time period equates to Raith's "PASSIVE TIMER, IS-136 SLEEP MODE, VOICE PAGE, IS-136 ACTIVE MODE, END, IS-136 SLEEP MODE," and we disagree.

Raith discloses (column 12, lines 30-36) that

> [w]hen the mobile station is in an IS-136 sleep mode and a page is received that indicates a terminating D-AMPS transaction, e.g., a voice call is being initiated with that mobile, the mobile station is assigned a traffic channel for the voice call as represented by step 4. After completion of the voice call, the mobile station returns to the IS-136 sleep mode as represented by step 5.

Thus, Raith teaches communicating in the second system in response to a call, not in response to a time period ending, and ending communication in the second system at the end of the particular call, not in response to a second time period ending. Since Raith fails to disclose communicating in the second system for a second predetermined time period, as recited as step (d) of claim 1, Raith fails to anticipate claim 1. Accordingly, we cannot sustain the anticipation rejection of claim 1 and its dependents, claims 2, 3, and 6 through 9.

Regarding claim 16, appellants (Brief, page 9) reference ***In re Donaldson***, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), and argue that the examiner has failed to identify any structure

in Raith for any of the means recited in parts (b) through (d) of claim 16. In particular appellants assert that the examiner has failed to point to any structure in Raith that corresponds to the claimed means for establishing and requesting a sleep value, means for communicating in the second communication system, and means for exiting the sleep mode and resuming communications in the first communication system. However, appellants have not pointed to any corresponding structure in the specification for any of the three means. Accordingly, we will interpret the means of claim 16 as encompassing any structure that will perform the recited functions.

Raith clearly teaches a means for registering the subscriber station in two communication systems, as Raith discloses (column 12, lines 16-18) that the mobile station has registered in both D-AMPS and PDCH modes of operation. Further, Raith (column 12, lines 25-28) teaches setting an active timer, and the mobile station entering a passive mode (or sleep mode) at the expiration of the active timer. The active timer and its associated time period satisfy the claimed means for establishing a sleep value which defines a time period after which the subscriber station enters a sleep mode in the PDCH system. As shown in Figure 6(b) and described at column 12, lines 28-36, while the mobile station

is still in the CDPD passive (sleep) mode, and a voice page is received, the mobile station communicates in the AMPS mode until the voice call is completed. Then the mobile station returns to the IS-136 sleep mode. Thus, the mobile station communicates in the second communication system while in the sleep mode for the first communication system. When a page message is received indicating a packet data transaction is being initiated, the mobile station enters the active mode for the first communication system again. Therefore, the incoming packet data constitutes means for exiting the sleep mode and resuming communication in the first communication system. Accordingly, Raith anticipates claim 16.[1]

For claim 10, the examiner combines Melanchuk with Raith. However, since Melanchuk fails to cure the deficiencies of Raith with regard to independent claim 1, the combination fails to render obvious dependent claim 10. Consequently, we cannot sustain the obviousness rejection of claim 10.

[1] We note that claim 16 differs from claim 1 in that it does not require that communication in the second system be for any particular length of time, just that it be while (i.e., sometime during the period that) the mobile station is in the sleep mode for the first communication system.

CONCLUSION

The decision of the examiner rejecting claim 9 under 35 U.S.C. § 112, second paragraph, claims 1 through 3 and 6 through 9 under 35 U.S.C. § 102(e), and claim 10 under 35 U.S.C. § 103 is reversed. The decision of the examiner rejecting claim 16 under 35 U.S.C. § 102(e) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

JERRY SMITH Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

APG/vsh

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